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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/738,992
Filing Date: December 19, 2000
Appellant(s): KURUOGLU ET AL.

Thomas Zell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/6/2006 appealing from the Office action
mailed 10/6/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5781727	Carleton	7-1998
6054990	Tran	7-1996
6351777	Simonoff	4-1999
5692073	Cass	11-1997
5680636	Levine	10-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carleton et al (US Patent 5781727, issued Jul 1998) in view of Tran (US Patent 6054990, filed Jul 1996), further in view of Simonoff (US 6351777, filed Apr 23, 1999), further in view of Cass (US 5692073, issued Nov 1997).

In regard to independent claim 1, Carleton teaches a *plurality of workstations comprising a computer processor, a display*. For example, Carleton discloses a collaborative system for allowing user to draw annotation images on the user display and replicating the annotation images to the displays of all other computers, where the computers are linked together for displaying to the users (col 1, line 65 – col 2, line 5).

Carleton teaches *a base computer communicating with the plurality of workstation*. For example, Carleton discloses a single computer runs an application and displays on other computers (col 1, line 65 – col 2, line 5).

Carleton does not expressly teach, but Tran teaches *a capture device for capturing a digital image of a document*. For example, Tran discloses a computer system with handwriting annotation with text or graphical illustration, camera, electronic notepad (co 2, lines 59-63; col 7, lines 46 - 60).

Carleton in view of Tran doesn't expressly teach, but Simonoff teaches *communicate data representing the identified annotation images to each workstation to permit an annotation entered at a first workstation to the hardcopy document and an annotation entered at a second workstation to the hardcopy document to be distributed to the plurality of workstations*. For example, Simonoff discloses users at dissimilar computers can annotate the information presented to all users (col 1, lines 20-25).

Carleton in view of Tran does not expressly teach, but Simonoff teaches *use of data representing the identified annotations for display with the digital images of the hardcopy document at the plurality of workstations according to display criteria for each workstation*. For example, Simonoff discloses a decoder at client computer that decodes at a user location so user can work on his/her own version (col 4, lines 40-50).

Carleton in view of Tran does not expressly teach, but Simonoff teaches *displaying the digital images of the hardcopy document at the workstations with one or more of the identified annotations entered at the first and second workstations*. For

example, Simonoff discloses first and second users instantiate objects on the whiteboard clients, that are relayed to the other clients (col 7, lines 5-18).

Carleton in view of Tran does not expressly teach, but Simonoff discloses the claimed limitation of *selectively displaying annotations in accordance with the display criteria for each workstation*. For example, Simonoff discloses remote users and a communication device that sends information to the remote users, where the interpreter decoder at each computer interprets and decodes the information specifying operations to be performed to the data at the remote computer site, allowing each user to make marks on their own version of the document (col 4, lines 35-50), which is displayed on the display device (col 4, lines 55-60). One of ordinary skill in the art at the time would have been motivated to by Simonoff's teachings to combine with Carleton and Tran in order to allow users to work independently from other users on documents at the same time (col 4, lines 47-50). The examiner interprets Simonoff's disclosure as equivalent to the claimed limitation because the remote user's are working independently on their own version which must be selected for displaying to that user in order to maintain the independence of the users at the same time.

Carleton in view of Tran and Simonoff does not teach, but Cass teaches annotations on a "*hardcopy*" document. For example, Cass discloses the image of a marked document instance, an image of a particular hardcopy instance of a document and on which instance the use has made a mark (graphical or written annotations) (Cass, lines 12-19).

Carleton in view of Tran and Simonoff does not expressly teach, but Cass teaches *identify handwritten annotations in digital images of document captured at each workstation*. Cass discloses an application in a paper-based World Wide Web user interface, called PaperWeb (Cass, col 3, lines 34-36), with a first document that has marks that the processor automatically extracts pixels representing the mark from the image (Cass, col 3, lines 39-50), where the digital scanning device scans a hardcopy instance of the first document to produce a first document image (col 3, lines 60-65), where the marks can be handwritten (col 8, line 39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton to include digital/graphical electronic files and handwritten annotations as taught by Tran, providing the benefit of creating and attaching text or graphical illustrations to a message, file, data set including photographic annotations depicting circumstances leading up the photograph/graphical image (Tran, col 2, lines 59-67), further to include displaying at remote user sites information to allow users to mark up documents allowing multiple users to work on their own version of documents at the same time by different sets of users, where first and second users collaboratively annotate objects on the whiteboard as taught by Simonoff, providing the benefit of facilitating interchange of information between two or more dissimilar computer users, where users can annotate the information presented to all users to allow users to mark up documents allowing multiple users to work on their own version of documents at the same time by different sets of users (Simonoff, 1, lines 20-30) further to include an application in a paper-based World Wide Web user interface with a first document that

has marks that the processor automatically extracts pixels representing the mark from the image, where the digital scanning device scans a hardcopy instance of the first document to produce a first document image to allow multiple users connected on the World Wide Web to add their marks on documents as taught by Cass, providing the benefit of using formless forms offering a new flexibility when applied in existing paper based user interfaces also providing new applications for paper-based user interface to allow multiple users connected on the World Wide Web to add their marks on documents (Cass, col 3, lines 30-37).

In regard to independent claim 11, Carleton teaches a *plurality of workstations of a collaborative annotation system*. For example, Carleton discloses a collaborative system for allowing user to draw annotation images on the user display and replicating the annotation images to the displays of all other computers, where the computers are linked together for displaying to the users (col 1, line 65 – col 2, line 5).

Carleton does not expressly teach, but Tran teaches *capturing a digital image of a document at each workstation*. For example, Tran discloses a computer system with handwriting annotation with text or graphical illustration, camera, electronic notepad (co 2, lines 59-63; col 7, lines 46 - 60).

Carleton in view of Tran does not expressly teach, but Simonoff teaches *using the data representing the identified annotations for display with the digital images of the hardcopy document at the plurality of workstations according to the display criteria for each workstation*. For example, Simonoff discloses a decoder at client computer that decodes at a user location so user can work on his/her own version (col 4, lines 40-50).

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Carleton in view of Tran does not expressly teach, but Simonoff teaches *displaying the digital images of the hardcopy document at the workstations with one or more of the identified annotations entered at the first and second workstations*. For example, Simonoff discloses first and second users instantiate objects on the whiteboard clients, that are relayed to the other clients (col 7, lines 5-18).

Carleton in view of Tran doesn't expressly teach, but Simonoff teaches *distributing data representing the identified annotation images to each workstation to permit an annotation entered at a first workstation to the hardcopy document and an annotation entered at a second workstation to the hardcopy document to be distributed to the plurality of workstations*. For example, Simonoff discloses users at dissimilar computers can annotate the information presented to all users (col 1, lines 20-25).

Carleton in view of Tran does not expressly teach, but Simonoff discloses the claimed limitation of *selectively displaying annotations in accordance with the display criteria for each workstation*. For example, Simonoff discloses remote users and a communication device that sends information to the remote users, where the interpreter decoder at each computer interprets and decodes the information specifying operations to be performed to the data at the remote computer site, allowing each user to make marks on their own version of the document (col 4, lines 35-50), which is displayed on the display device (col 4, lines 55-60). One of ordinary skill in the art at the time would have been motivated to by Simonoff's teachings to combine with Carleton and Tran in order to allow users to work independently from other users on documents at the same time (col 4, lines 47-50). The examiner interprets Simonoff's disclosure as equivalent to

the claimed limitation because the remote user's are working independently on their own version which must be selected for displaying to that user in order to maintain the independence of the users at the same time.

Carleton in view of Tran does not teach, but Simonoff teaches *wherein the one or more of the annotations are selectable at each workstation for retrieving information associated with each selectively displayed annotation, including information concerning each annotation's creation and author*. For example, Simonoff teaches a decoder at a client computer that decodes at a user location so user can work on his/her own version of the document (col 4, lines 40-50). The examiner interprets this disclosure as equivalent to the claimed invention because if a decoder can decode for an individual user, then the decoder must have the capability to identify a user.

Carleton in view of Tran and Simonoff does not teach, but Cass teaches annotations on a "*hardcopy*" document. Cass discloses an image of a marked document instance, an image of a particular hardcopy instance of a document and on which instance the use has made a mark (graphical or written annotations)(Cass, lines 12-19).

Carleton in view of Tran and Simonoff does not expressly teach, but Cass teaches *identifying a portion of the digital image corresponding to a handwritten annotation in the hardcopy document captured at a first workstation and a second workstation*. For example, Cass discloses an application in a paper-based World Wide Web user interface, called PaperWeb (Cass, col 3, lines 34-36), with a first document that has marks that the processor automatically extracts pixels representing the mark

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from the image (Cass, col 3, lines 39-50), where the digital scanning device scans a hardcopy instance of the first document to produce a first document image (col 3, lines 60-65), where the marks can be handwritten (col 8, line 39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton to include digital/graphical electronic files and handwritten annotations as taught by Tran, providing the benefit of creating and attaching text or graphical illustrations to a message, file, data set including photographic annotations depicting circumstances leading up the photograph/graphical image (Tran, col 2, lines 59-67), further to include displaying at remote user sites information to allow users to mark up documents allowing multiple users to work on their own version of documents at the same time by different sets of users, where first and second users collaboratively annotate objects on the whiteboard as taught by Simonoff, providing the benefit of facilitating interchange of information between two or more dissimilar computer users, where users can annotate the information presented to all users to allow users to mark up documents allowing multiple users to work on their own version of documents at the same time by different sets of users (Simonoff, 1, lines 20-30) further to include an application in a paper-based World Wide Web user interface with a first document that has marks that the processor automatically extracts pixels representing the mark from the image, where the digital scanning device scans a hardcopy instance of the first document to produce a first document image to allow multiple users connected on the World Wide Web to add their marks on documents as taught by Cass, providing the benefit of using formless forms offering a new flexibility when applied in existing paper

based user interfaces also providing new applications for paper-based user interface to allow multiple users connected on the World Wide Web to add their marks on documents (Cass, col 3, lines 30-37).

In regard to independent claim 12, Carleton teaches *a base computer communicating with a plurality of workstations of a collaborative annotation system*. For example, Carleton discloses a collaborative system, on a single computer, for allowing user to draw annotation images on the user display and replicating the annotation images to the displays of all other computers, where the computers are linked together for displaying to the users (col 1, line 65 – col 2, line 5).

Carleton does not expressly teach, but Tran teaches *a capture device for capturing a digital image of a document*. For example, Tran discloses a computer system with handwriting annotation with text or graphical illustration, camera, electronic notepad (co 2, lines 59-63; col 7, lines 46 - 60).

Carleton in view of Tran doesn't expressly teach, but Simonoff teaches *communicate data representing the identified annotation images to each workstation to permit an annotation entered at a first workstation to the hardcopy document and an annotation entered at a second workstation to the hardcopy document to be distributed to the plurality of workstations*. For example, Simonoff discloses users at dissimilar computers can annotate the information presented to all users (col 1, lines 20-25).

Carleton in view of Tran does not expressly teach, but Simonoff teaches *using the data representing the identified annotations for display with the digital images of the hardcopy document at the plurality of workstations according to the display criteria for*

each workstation. For example, Simonoff discloses a decoder at client computer that decodes at a user location so user can work on his/her own version (col 4, lines 40-50).

Carleton in view of Tran does not expressly teach, but Simonoff teaches *displaying the digital images of the hardcopy document at the workstations with one or more of the identified annotations entered at the first and second workstations.* For example, Simonoff discloses first and second users instantiate objects on the whiteboard clients, that are relayed to the other clients (col 7, lines 5-18).

Carleton in view of Tran does not expressly teach, but Simonoff discloses the claimed limitation of *selectively displaying annotations in accordance with the display criteria for each workstation.* For example, Simonoff discloses remote users and a communication device that sends information to the remote users, where the interpreter decoder at each computer interprets and decodes the information specifying operations to be performed to the data at the remote computer site, allowing each user to make marks on their own version of the document (col 4, lines 35-50), which is displayed on the display device (col 4, lines 55-60). One of ordinary skill in the art at the time would have been motivated to by Simonoff's teachings to combine with Carleton and Tran in order to allow users to work independently from other users on documents at the same time (col 4, lines 47-50). The examiner interprets Simonoff's disclosure as equivalent to the claimed limitation because the remote user's are working independently on their own version which must be selected for displaying to that user in order to maintain the independence of the users at the same time.

Carleton in view of Tran and Simonoff does not expressly teach, but Cass teaches *identifying handwritten annotations in digital images of the hardcopy document captured at each workstation*. For example, Cass discloses an application in a paper-based World Wide Web user interface, called PaperWeb (Cass, col 3, lines 34-36), with a first document that has marks that the processor automatically extracts pixels representing the mark from the image (Cass, col 3, lines 39-50), where the digital scanning device scans a hardcopy instance of the first document to produce a first document image (col 3, lines 60-65), where the marks can be handwritten (col 8, line 39).

Carleton in view of Tran and Simonoff does not teach, but Cass teaches annotations on a "hardcopy" document. For example, Cass discloses image of a marked document instance, an image of a particular hardcopy instance of a document and on which instance the use has made a mark (graphical or written annotations)(Cass, lines 12-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton to include digital/graphical electronic files and handwritten annotations as taught by Tran, providing the benefit of creating and attaching text or graphical illustrations to a message, file, data set including photographic annotations depicting circumstances leading up the photograph/graphical image (Tran, col 2, lines 59-67), further to include displaying at remote user sites information to allow users to mark up documents allowing multiple users to work on their own version of documents at the same time by different sets of users, where first and second users collaboratively

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annotate objects on the whiteboard as taught by Simonoff, providing the benefit of facilitating interchange of information between two or more dissimilar computer users, where users can annotate the information presented to all users to allow users to mark up documents allowing multiple users to work on their own version of documents at the same time by different sets of users (Simonoff, 1, lines 20-30) further to include an application in a paper-based World Wide Web user interface with a first document that has marks that the processor automatically extracts pixels representing the mark from the image, where the digital scanning device scans a hardcopy instance of the first document to produce a first document image to allow multiple users connected on the World Wide Web to add their marks on documents as taught by Cass, providing the benefit of using formless forms offering a new flexibility when applied in existing paper based user interfaces also providing new applications for paper-based user interface to allow multiple users connected on the World Wide Web to add their marks on documents (Cass, col 3, lines 30-37).

Regarding claims 2 and 13, Carleton in view of Tran does not expressly teach, but Simonoff teaches identifying a new annotation made at a third workstation or an additional annotation made by the first or second workstations, and to update the distribution of annotations to the plurality of workstations. For example, Simonoff discloses a user can add objects to whiteboard displayed; update information (col 16, lines 25-34; col 1, line 24)(col 1, line 24 teaches updating the information presented to all users).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran to include adding objects to whiteboard displays to update information as taught by Simonoff, providing the benefit of facilitating collaboration between a plurality of users (Simonoff, Abstract section).

In regard to dependent claims 3 and 14, Carleton does not teach, but Tran teaches capture device at least one workstation comprises a camera. For example, Tran discloses a digital camera (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton to include a camera as taught by Tran, providing the benefit of annotations to graphical messages, files (Tran, col 2, lines 59-65).

In regard to dependent claims 4 and 15, Carleton teaches information representing the annotation as a bitmap (col 10, line 9 –11).

Carleton teaches information indicating the location of the annotation in a document. For example, Carleton discloses an annotation logic draws corresponding annotation at the remote computer as from the original computer (col 7, lines 28-38).

Carleton in view of Tran and Simonoff does not teach, but Cass teaches annotations on a “hardcopy” document. For example, Cass discloses image of a marked document instance, an image of a particular hardcopy instance of a document and on which instance the use has made a mark (graphical or written annotations)(Cass, lines 12-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran and Simonoff to include annotations of an

image of an image of a particular hardcopy instance document as taught by Cass, providing the benefit of using formless forms offering a new flexibility when applied in existing paper based user interfaces also providing new applications for paper-based user interface (Cass, col 3, lines 30-37).

In regard to dependent claims 5 and 16, Carleton in view of Tran does not expressly teach the origin of the annotation, but Simonoff teaches it. For example, Simonoff discloses the server maintains a list of files and their origination, where the files contain annotations/updates from various client users (col 10, lines 35-65; Fig 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran to include a server that maintains a list of files and their origination as taught by Simonoff, providing the benefit of facilitating collaboration between a plurality of users (Simonoff, Abstract section) and distinguishing the origin location of annotations.

In regard to dependent claims 6 and 17, Carleton in view of Tran does not teach the annotation object further comprising information representing the identity of the digital image of the hardcopy document with which the annotation is associated, but Simonoff teaches it. For example, Simonoff discloses the server maintains a list of files and their meta-data associated with files that contain annotations (Fig 6, see column labeled 'uploaded').

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran to include a server that maintains a list of files and their meta-data associated with files that contain annotations as taught by

Simonoff, providing the benefit of facilitating collaboration between a plurality of users (Simonoff, Abstract section).

In regard to dependent claim 8, Carleton in view of Tran does not expressly teach, but Simonoff teaches plurality of workstations is operative to display annotations in a plurality of different colors according to its display criteria, the color being indicative of the origin of the annotation. For example, Simonoff discloses where an individual user selects a drawing color for the annotations (col 11, lines 44-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran to include individual user to select a drawing color as taught by Simonoff, providing the benefit of facilitating collaboration between a plurality of users (Simonoff, Abstract section) and distinguishing the origin location of annotations.

In regard to dependent claim 9, Carleton teaches each workstation is operative to identify handwritten annotations (col 1, lines 65 – col 2, line 5).

In regard to dependent claim 10, Carleton does not specifically teach, but Tran teaches the base computer is operative to identify handwritten annotations (col 7, lines 46 – 65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton to include a base computer that accepts handwritten input as taught by Tran, providing the benefit of attaching graphical illustrations with annotations as an option for users.

In regard to dependent claim 19, Carleton teaches annotations originating from at least two different other workstations. For example, Carleton discloses three mice, three cursors, three arrows (col 4, lines 60-67).

In regard to dependent claim 20, Carleton in view of Tran does not expressly teach, but Simonoff teaches each annotation is selectively displayed in a color indicative of the origin of the annotation according to the displayed criteria. For example, Simonoff discloses where an individual user selects a drawing color for the annotations (col 11, lines 44-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran to include individual user to select a drawing color as taught by Simonoff, providing the benefit of facilitating collaboration between a plurality of users (Simonoff, Abstract section) and distinguishing the origin location of annotations.

Regarding claims 21 and 22, Simonoff teaches one or more of annotations are selectable at each workstation for retrieving information associated with each selectively displayed annotation, including information concerning each annotation's creation and author. For example, Simonoff discloses a whiteboard server maintains the specific client origination of the upload concerning identity of user (col 10, lines 35-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran to include whiteboard server that maintains the specific client origination of the upload, including identity of user as taught by

Simonoff, providing the benefit of facilitating collaboration between a plurality of users (Simonoff, Abstract section) and distinguishing the origin location of annotations.

Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carleton (as cited above) in view of Tran (as cited above) and Simonoff (as cited above), further in view of Levine et al (US Patent 5680636, issued Oct 1997), further in view of Cass (as cited above).

In regard to dependent claims 7 and 18, Carleton in view of Tran and Simonoff does not teach, but Levine teaches *information representing the identity of the document with which the annotation is associated*. For example, Levine discloses reference to a document by the base name of the superfile/stamp file (col 21, lines 15-22). The examiner interprets this disclosure as equivalent to the claimed identity of the digital document because the name of document identifies a document and Levine discloses this named document in a digital processing system for a document annotation system where users can annotate documents and store them in a indexed filing system (col 1, lines 15-25).

Carleton in view of Tran, Simonoff and Levine does not teach, but Cass teaches annotations on a "*hardcopy*" document. For example, Cass discloses an image of a marked document instance, an image of a particular hardcopy instance of a document and on which instance the user has made a mark (... graphical or written annotations)(Cass, lines 12-19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carleton in view of Tran and Simonoff to include a catalog of

annotations as taught by Levine, providing the benefit of having a friendlier computer device (col 1, lines 50-55) and a means to access the documents that contain annotations further to include annotations of an image of an image of a particular hardcopy instance document as taught by Cass, providing the benefit of using formless forms offering a new flexibility when applied in existing paper based user interfaces also providing new applications for paper-based user interface (Cass, col 3, lines 30-37).

(10) Response to Argument

Regarding independent claims 1 (and it's dependent claims 2-6, 8-10 and 21), 11 and 12 (and its dependent claims 13-17, 19-20 and 22), the Appellant argues that the Carleton reference in combination with Tran, Simonoff and/or Cass fails to disclose or suggest the invention of claim 1 read as a whole which includes identifying handwritten annotations made to a hardcopy document captured at a first and a second workstations, which annotations are communicated to each workstation where one or more of the annotations are selectively displayed in accordance with display criteria of each workstation (see Brief, pages 8-14).

The Examiner disagrees. Cass discloses an application in a paper-based World Wide Web user interface, called PaperWeb (Cass, col 3, lines 34-36), with a first document that has marks that the processor automatically extracts pixels representing the mark from the image (Cass, col 3, lines 39-50), where the digital scanning device scans a hardcopy instance of the first document to produce a first document image (col 3, lines 60-65), where the marks can be handwritten (col 8, line 39). This disclosure by Cass is

equivalent to the claimed *identify handwritten annotations in digital images of the hardcopy document captured at each workstation*.

Cass further discloses the claimed limitation of *communicate data representing the identified annotation images to each workstation*. For example, Cass discloses in Fig 14, an instance of a document (item 700) where the user wants to input to an image of a document that was faxed to the processor and is unmarked (col 14, lines 25-30), and Fig 15 shows an instance (item 800') of document (item 700) which is a marked instance (item 810, item 820) of the document (col 14, lines 31-40). Cass further discloses a user situated at a fax machine located remotely to a host computer that is in connection with the web, where the computer runs software to support the Paper Web browser. The computer retrieves a Web page and faxes a hardcopy to the retrieved page to the user. The user marks the hardcopy (i.e., circles, underlines or other drawings) and then the user faxes the hardcopy marked back to the computer (col 16, lines 50-64; Fig 20 shows the printed web page marked by the user). Once the marked copy is saved as a document, another user can come later on and retrieve the web page and generate the hardcopy of the retrieved page that was marked by a previous user and fax the hardcopy back to the computer which is saved with the most recent user's marks.

The Cass reference (issued as a patent in 1997) provides a significant benefit in the art that precludes the Appellant's invention. Specifically, Cass provides a way to bring paper documents to life by turning ordinary, inactive/nonhypertext document into active-forms and hypertext documents for computer users that can access the Web and

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save the documents in image-based indexing of a marked document instances (Cass, col 19, lines 43-60).

Simonoff discloses the claimed limitation of *selectively displaying annotations in accordance with the display criteria for each workstation*. For example, Simonoff discloses remote users and a communication device that sends information to the remote users, where the interpreter decoder at each computer interprets and decodes the information specifying operations to be performed to the data at the remote computer site, allowing each user to make marks on their own version of the document (col 4, lines 35-50), which is displayed on the display device (col 4, lines 55-60). One of ordinary skill in the art at the time would have been motivated to by Simonoff's teachings to combine with Carleton and Tran in order to allow users to work independently from other users on documents at the same time (col 4, lines 47-50). The examiner interprets Simonoff's disclosure as equivalent to the claimed limitation because the remote user's are working independently on their own version which must be selected for displaying to that user in order to maintain the independence of the users at the same time.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the references Carleton, Tran, Simonoff and Cass to arrive at the claimed invention because Cass discloses an application in a paper-based World Wide Web user interface with a first document that has marks that the processor automatically extracts pixels representing the mark from the image (Cass, col 3, lines 39-50), where the digital scanning device scans a hardcopy instance of the first

document to produce a first document image to allow multiple users connected on the World Wide Web to add their marks on documents and Simonoff discloses displaying at remote user sites information to allow users to mark up documents allowing multiple users to work on their own version of documents at the same time by different sets of users, and combining these disclosure to the disclosures of Carelton for a collaborative system for allowing users to draw annotation images on the user display for multiple users in view of Tran that discloses a computer system with handwriting annotations. All of the references are closely related because they are in the same field of endeavor, annotations/marks to documents, performed by users. Additionally, the references deal with users working in distributed environments and a shared issue of multiple users, working at their own computers to interact with shared documents/information (i.e., by annotating or marking).

The Examiner's arguments regarding claims 11 and 12 are similar to those discussed above with respect to claim 1 because the Appellant states that Appellant's arguments presented above regarding claim 1 apply equally to claims 11 and 12. Regarding dependent claims 2-6, 8-10 and 13-17, the Appellant relies on the allowability of the respective independent claims 1 and 12. Accordingly, The Examiner maintains the rejections as set forth in the rejection set forth above.

Regarding dependent claims 7 and 18, the Appellant argues that the Carleton reference in combination with Tran, Simonoff, Cass and/or Levine fails to discloses the annotations object with information representing the identity of the digital image of the hardcopy document with which the annotation is associated (see Brief, pages 14-16).

The Examiner disagrees. Levine discloses reference to a document by the base name of the superfile/stamp file (col 21, lines 15-22). The examiner interprets this disclosure as equivalent to the claimed identity of the digital document because the name of document identifies a document and Levine discloses this named document in a digital processing system for a document annotation system where users can annotate documents and store them in a indexed filing system (col 1, lines 15-25). Levine's disclosure alleviates the Appellant's concern about cataloguing information representing the identity of a digital image.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Gautam Sain

GS 8/16/06
Patent Examiner

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